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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,671	07/20/2006	Daria Onichtchouk	2923-766	4738

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EXAMINER	
HAMA, JOANNE	

ART UNIT	PAPER NUMBER
1632	

NOTIFICATION DATE	DELIVERY MODE
05/29/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No.	Applicant(s)	
	10/586,671	ONICHTCHOUK, DARIA	
	Examiner	Art Unit	
	JOANNE HAMA	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-39* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

This Application, filed July 20, 2006, is a 371 of PCT/EP05/00491, filed January 19, 2005 and claims priority to Application 04001113.2, filed January 20, 2004 at the European Patent Office.

Amendments to the claims were filed July 20, 2006.

Claims 1-39 are pending.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1, 12-17, 35, drawn to a composition comprising a nucleic acid encoding DG147, DG147 protein, and a modulator/effector of the nucleic acid encoding DG147.

Group 2, claim(s) 1, 12-17, 35, drawn to a composition comprising a nucleic acid encoding DG147, DG147 protein, and a modulator/effector of DG147 protein.

Group 3, claim(s) 1, 12-17, 35, drawn to a composition comprising DG147 protein, and a modulator/effector of the nucleic acid encoding DG147.

Group 4, claim(s) 1, 12-17, 35, drawn to a composition comprising DG147 protein, and a modulator/effector of DG147 protein.

Group 5, claim(s) 1-8, 12-17, 22, 23, 35, drawn to a composition comprising a nucleic acid encoding DG147, a vector comprising a nucleic acid encoding DG147, and a cell comprising a nucleic acid encoding DG147.

Group 6, claim(s) 1, 9-10, 12-17, 35, drawn to DG147 protein.

Group 7, claim(s) 1, 2, 11-17, 35, drawn to antisense of DG147.

Group 8, claim(s) 18, 30, 32, 33, drawn to use of a nucleic acid encoding DG147 or a vector comprising a nucleic acid encoding DG147, or a cell comprising a nucleic acid encoding DG147, for the treatment of a disease or disorder.

Group 9, claim(s) 19, drawn to use of a nucleic acid for identifying substances capable of interacting with a DG147 protein.

Group 10, claim(s) 20, 21, drawn to a non-human transgenic animal exhibiting a modification in the expression of a DG147 polypeptide.

Group 11, claim(s) 24, drawn to a method of identifying a polypeptide involved in the regulation of energy homeostasis and/or differentiation of adipocytes comprising.

Group 12, claim(s) 25, drawn to a method of screening for an agent which modulates/effects the interaction of a DG147 polypeptide, wherein the method comprises incubating a mixture of DG147 polypeptide, a binding target or agent, and a candidate agent.

Group 13, claim(s) 26, drawn to a method of screening for an agent which modulates/effects the interaction of a DG147 polypeptide, wherein the method comprises incubating a mixture of DG147 polypeptide and a candidate target or agent.

Group 14, claim(s) 27, 28, drawn to a method of producing a composition comprising the polypeptide identified by the method of claim 24.

Group 15, claim(s) 29, drawn to use of a polypeptide as identified by the method of claim 24 in a method of treating a disease or disorder.

Group 16, claim(s) 31, drawn to use of a polypeptide as defined in claim 1 for the treatment of a disease or disorder.

Group 17, claim(s) 34, drawn to use of a nucleic acid encoding DG147 for the production of a non-human transgenic animal which over- or under-expresses the DG147 product.

Group 18, claim(s) 35, drawn to a kit comprising an aptamer and/or another modulator/effector of the nucleic acid encoding DG147.

Group 19, claim(s) 35, drawn to a kit comprising an antibody or aptamer and/or another modulator/effector of the DG147 protein.

Group 20, claim(s) 36, drawn to a method of producing a composition comprising the agent identified by the method of claim 25.

Group 21, claim(s) 37, drawn to a method of producing a composition comprising the agent identified by the method of claim 26.

Group 22, claim(s) 38, drawn to use of an agent identified by the method of claim 25 for the treatment of a disease or disorder.

Group 23, claim(s) 39, drawn to use of an agent identified by the method of claim 26 for the treatment of a disease or disorder.

The inventions listed as Groups 1-23 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature, DG147, was known at the time of filing. Example 2 of the specification indicates that DG147 is known by a particular GenBank Accession Number. A search of GenBank No. NM_001831 indicates that the nucleic acid encodes human clusterin. Clusterin was well known at the time of filing. Monia et al., US Patent 6,383,808 teach antisense of the clusterin gene.

The claims are further restricted.

Claims 18, 30, 32, 33 of Group 8; claim 29 of Group 15; claim 31 of Group 16; claim 38 of Group 22; and claim 39 of Group 23 are drawn to distinctly named diseases or disorders that are treated by using a nucleic acid encoding DG147 and one disease or disorder must be elected.

Claim 21 of Group 10 is drawn to distinctly named expression activities of DG147, increased or reduced, and either “increased” or “reduced” must be elected.

Claim 24 of Group 11 is drawn to distinctly named types of activities that polypeptides obtained from a screen have, energy homeostasis and/or differentiation, and Applicant must elect one activity or elect that the polypeptides identified in the screen have both activities.

Claim 34 of Group 17 is drawn to two distinctly named gene expression patterns of the non-human transgenic animal: overexpression or underexpression and either overexpression or underexpression must be elected.

MPEP 1893.03(d) states: If an examiner (1) determines that the claims lack unity of invention and (2) requires election of a single invention, when all of the claims drawn to the elected invention are allowable (i.e., meet the requirements of 35 U.S.C. 101, 102, 103 and 112), the nonelected invention(s) should be considered for rejoinder. Any nonelected product claim that requires all the limitations of an allowable product claim, and any nonelected process claim that requires all the limitations of an allowable process claim, should be rejoined. See MPEP § 821.04 and § 821.04(a). Any nonelected processes of making and/or using an allowable product should be considered for rejoinder following the practice set forth in MPEP § 821.04(b).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Hama, Ph.D. whose telephone number is 571-272-2911. The examiner can normally be reached Mondays, Tuesdays, Thursdays, and Fridays from 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras, can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system

provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Joanne Hama/
Art Unit 1632